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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,645	07/25/2003	Douglas G. Placek	240932US0	1403
22850	7590	08/18/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			KHAN, AMINA S	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,645

Applicant(s)

PLACEK ET AL.

Examiner

Amina Khan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

2. Claims 4-22 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot be dependent on another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-22 have not been further treated on the merits.

Claim Rejections - 35 USC § 102

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Liesen (US Publication #US 2004/0092409).

6. The Liesen prior art teaches alkyl(meth)acrylate copolymers to be used in lubricating oils that comprise 10-23 weight percent C₃-C₇ alkyl(meth)acrylate, which meets the claimed limitation of 1-100% of ethylenically unsaturated esters of formula (I); from 77-90 weight percent C₁₂-C₁₄ alkyl(meth)acrylate; and from 0-6 weight percent of at least one C₆-C₂₀ alkyl(meth)acrylate, which meets the claimed limitation of 0-99% of ethylenically unsaturated esters of formula (II) (abstract, paragraph 1, lines 1-7).

7. The Liesen prior art further teaches lubricating oil compositions for use in hydraulic fluids (page 7, paragraph 0061, lines 1-5) comprising esters of dicarboxylic

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acids (page 7, paragraph 0058, lines 1-5), polyol ethers (page 7, paragraph 0059, lines 1-3), and phosphorous containing acids (page 7, paragraph 0060, lines 7-10), which meets the claimed limitation of organophosphorous compounds.

8. The prior art is silent about the claimed properties of the oxygen containing component of the functional fluid of a fire point according to ASTM D 92 of at least 250°C as claimed in claim 2 and a kinematic viscosity at 40°C according to ASTM D 445 of 35 mm²/s or less as claimed in claim 3. However, it is reasonable to presume that the claimed properties are well within the scope of the teachings of the prior art because the presumption is supported by the use of similar oxygen containing compounds: the esters of dicarboxylic acids- azelaic acid or sebacic acid (page 7, paragraph 0058, lines 2-4); the polyol ether- neopentyl glycol (page 7, paragraph 0059, lines 1-3); and the organophosphorous compound- tricresyl phosphate (page 7, paragraph 0060, lines 7-10) between the prior art and the instant application. The burden is on the applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594.

9. Accordingly, the broad teachings of Liesen anticipate the material limitations of the instant claims.

10. Alternatively, even if the broad teachings of Liesen are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to arrive at a fire point according to ASTM D 92 of at least 250°C and a kinematic viscosity at 40°C according to ASTM D 445 of 35 mm²/s since the prior art teaches the equivalent oxygen containing components azelaic acid, sebacic acid (page 7, paragraph 0058, lines 2-4), neopentyl glycol (page 7, paragraph

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0059, lines 1-3), and tricresyl phosphate (page 7, paragraph 0060, lines 7-10) which would have the claimed fire points and kinematic viscosities.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The relevant prior art is Liesen et al. (US Patent #6323164), Richard (US Patent #3718596), Holgado et al. (US Patent #6521142, Roos et al. (US Publication #US 2003/0060587), and Gore et al. (US Publication #US 2002/0123583).

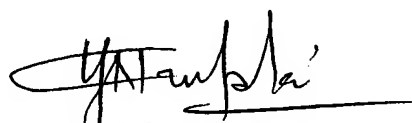
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amina Khan whose telephone number is (571) 272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Amina Khan, PhD
Patent Examiner
August 5, 2005



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